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TO: Examiner Alain L. Bashore
Group Art Unit 3624
U.S. Patent and Trademark Office

FAX NO. 703-872-9306

FROM: Jimmy L. Heisz

RE: U.S. Serial No. 09/603,510
Attorney Docket No. STUD-0001

DATE: August 2, 2004

PAGES: 8 (including cover page)

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ATTORNEY DOCKET NO. STUD-0001

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Arthur Dale Burns
Serial No.: 09/603,510
Filed: June 26, 2000
Title: STUDENT LOAN CONSOLIDATION QUALIFICATION SYSTEM
AND METHOD OF OPERATION THEREOF
Grp./A.U.: 3624
Examiner: Alain L. Bashore

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that this correspondence is being facsimile
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Stephanie P. Pitt
Typed or printed name of person signing this certificate
Signature

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

The Applicant has carefully considered this application in connection with the Examiner's Action mailed June 2, 2004 and respectfully requests reconsideration of this application in view of the following remarks. The Applicant originally submitted Claims 1-22 in the application. The Applicant previously amended independent Claims 1, 9 and 16. The Applicant has not amended, canceled or added any claims herein. Accordingly, Claims 1-22 are currently pending in the application.

I. Rejection of Claims under 35 U.S.C. §103

The Examiner rejected Claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over Tengel, *et al.*, U.S. Patent No. 5,940,812 (Tengel), in view of Levine, *et al.*, U.S. Patent No. 6,233,566B1 (Levine), and Mottola, *et al.*, U.S. Patent No. 5,745,885 (Mottola). The Examiner rejected Applicant's argument that Levine and Tengel are non-analogous art based on the fact that both references are concerned with the "loan life cycle" as described by Levine. The Applicant does not understand the Examiner's statement that "[t]he art recognizes the loan process as a whole and the concerns that one with ordinary skill in the art would utilize techniques and apparatus of the loan life cycle to *solve problems dealing with all aspects of loans.*" (Emphasis added) (Office Action, page 5). Is the Examiner suggesting that a person of ordinary skill in the art of making loans is also considered skilled in the art of buying and selling loans? Is the Examiner suggesting that a bank lending officer having ordinary skill in the art of making consumer loans is equally adept with all aspects of loans throughout a "loan life cycle" from origination, to securitization, to bankruptcy workouts if a loan turns sour? The Applicant suggests that such is not the case.

Although Levine and Tengel each address certain aspects of loans, the respective fields or endeavor are light years apart. Tengel describes a loan origination system for matching loans with a potential borrower via a telecommunications network and is directed to the gathering of information with respect to the issuance of new loans. Tengel provides no guidance or insight with respect to combining or refinancing existing loans. Tengel does not directly or indirectly address or suggest gathering information from a loan applicant with respect to a plurality of existing and outstanding loans with a view to qualifying both the applicant and the loans for consolidation. Tengel only provides a mechanism for determining if a potential borrower has the financial

wherewithal to withstand the burden of incurring a larger amount of debt and does not teach or suggest a system for reducing a borrower's financial burden by consolidating loans. In addition to not addressing student loans or loan consolidation issues, Tengal also does not address lender contact or interaction with the borrower unless and until the borrower initiates such contact. (Col. 9, lines 60-62).

Levine does not overcome the shortcomings of Tengal. Levine addresses issues relating to the business of buying and selling financial products. Nothing in Levine suggests that the system described therein could be usefully employed in any aspect of the lending or debt consolidation business. The portion of Levine cited by the Examiner is background information and is not relevant to the gravamen of the teachings or suggestions of Levine. It goes without saying that all financial products must be created and this background excerpt only addresses how loans can be created. In fact, the cited portion does not deal with any aspect of an loan qualification system over the Internet. Instead, Levine teaches that the origination of loan products is generally handled through a call center, which teaches away from the present invention.

The Applicant reiterates that the references are not analogous because they deal with vastly different financial disciplines. A person of ordinary skill in the art of lending and loan origination, such as a banker, would not resort to Levine in order to overcome any shortcomings in Tengal. Nor would a person of ordinary skill in the art of purchasing and selling financial instruments, such as a stockbroker, look to Tengal for teachings or suggestions with respect to financial markets. The respective areas of endeavor are quite distinct. Levine does not address any aspect of the loan business such as loan processing, loan applications, credit assessment, etc.

Although the Examiner has made an attempt to set forth reasons why a person of ordinary skill in the pertinent art would be motivated to combine references, the Applicant suggests that the reasons set forth do not rise to a level of specificity required to motivate a person skilled in the pertinent art to combine the teachings of Levine with Tengal. Referring again to *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), where the Federal Circuit stated that:

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reasons the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffett*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the would have been motivated to select the references and to combine to render the claimed invention obvious.") *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

No objective factor has been given that would motivate a person of ordinary skill in the pertinent art to refer to the respective references and then to combine them. There is no teaching or suggestion in either reference that the two references should be combined nor the desirability of such a combination. As stated in *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), "[t]he mere fact that ... disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination." *In re Imperato*, 486 F. 2d 585, 587, 179 USPQ 730, 732 (CCPA 1973). "The mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior

art suggested the desirability of the modification.” *Ex parte* Dussaud, 7 USPQ1818, 1820 (Bd. App. & Int’f 1986).

The Applicant also disagrees with the Examiner’s statement that both deal with financial manipulation of loans. Levine does not address any aspect of the issuance or manipulation of loans or loan terms. Levine only addresses the marketing of financial instruments of which loans are but one type. Levine does not address modifications of loan terms, rates or any other aspect of “loan manipulation.” Levine deals “market manipulation” where loans are a product, Tengal deals with the creation or manipulation of loans and their terms that, when completed, may or may not become a financial product. Stated slightly differently, Tengal addresses the field of lending and creating loans by manipulating the loan structure, whereas Levine addresses manipulating a market for investments. It is well established by those skilled in the respective relevant art that the two endeavors are each distinct from the other, both as to the necessary skills brought to bear as well as the subject matter itself. Tengal and Levine address clearly defined separate fields of recognized endeavors and to suggest otherwise is, at best, speculative. The mere fact that isolated references are found to establish a combination does not render the combination obvious unless something suggests the desirability of the combination, which is not the case here. Tengal, individually or in combination with Levine, thus fails to teach or suggest the invention recited in independent Claims 1, 9 and 16 and their dependent claims, when considered as a whole. Claims 1-22 are therefore not obvious in view of Tengal and Levine.

The system described in Mottola also does not overcome the shortcomings in Tengal. As previously stated, Mottola disparages student loans and uses their perceived shortcomings as justification for its alternative higher education funding plan. Mottola this teaches away from using

student loans to finance a loan applicant's higher education. (Col. 1, lines 15-67; Col. 2, lines 1-13). Mottola is directed solely to a "method and apparatus for implementing and administering a plan of investments for financing higher education". (Col. 1, lines 17-18). Mottola does not include loans in the plan of investment nor does Mottola describe or suggest the consolidation of outstanding student loans.

Tengel, individually or in combination with Mottola, thus fails to teach or suggest the invention recited in independent Claims 1, 9 and 16 and their dependent claims, when considered as a whole. Claims 1-22 are therefore not obvious in view of Tengal and Mottola. In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 1-22 under 35 U.S.C. §103(a). The Applicant therefore respectfully requests the Examiner to withdraw the rejection.

II. Conclusion

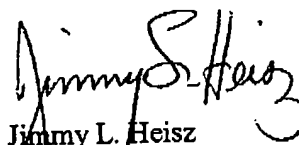
In view of the foregoing remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-22.

It is not believed that any fees are due for this communication, however, the Commissioner is hereby authorized to charge any possible fees connected with this communication to Deposit Account No. 08-2395.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

HITT GAINES, P.C.


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Dated: August 2, 2004

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